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EXAMINER

OKEBATO, SAHLU

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN G. ELIAS

Appeal 2015-004555
Application 11/620,424
Technology Center 2600

Before JOSEPH L. DIXON, TERRENCE W. McMILLIN, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

On Nov. 14, 2016, Appellant filed a Request for Rehearing (hereinafter “Req. Reh’g”) under 37 C.F.R. § 41.52 from the Decision on Appeal (Decision) of the Patent Trial and Appeal Board (Board), mailed Sep. 14, 2016.¹ In the Decision, we affirmed the Examiner’s Final Rejection of claims 1–7, 9–12, and 14–34.

We deny the Request for Rehearing.

¹ “The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.”
37 C.F.R. § 41.52(a)(1).

In their Request, Appellant asserts “[t]he Decision misapprehended the Examiner’s rejection of the claim limitation at issue and thereby overlooked that Appellant properly addressed the proposed rejection, as a whole.” (Req. Reh’g. 2.) The following claim element is at issue:

[T]he hand-held electronic device comprising a display element on a first surface of the hand-held electronic device and a touch surface on a second surface of the electronic device, the touch surface including at least one physical representation of a control element. . . .

(App. Br. 5.) In the Final Action, the Examiner relied on both Liebenow and Kraus in finding the combination teaches or suggests this claim element:

Liebenow discloses a method for operating a hand-held electronic device, the hand-held electronic device comprising a display element on a first surface of the hand-held electronic device (front surface 204 and display 216, fig. 7) and a touch surface on a second surface of the electronic device (back surface 206 and touch sensitive panel 240, fig. 9). . . .

* * *

Liebenow does not explicitly disclose the touch surface including at least one physical representation of a control element.

However, Kraus discloses the touch surface (304, fig. 3) including at least one physical representation of a control element ([0037] and key area 300, rigid frame 314 and keyboard overlay 110, fig. 3d; wherein the keyboard overlay configuration shows in fig. 4).

(Final Act. 2–3.) Appellant mischaracterizes the rejection, asserting “the Examiner conceded the Liebenow does not disclose the claim limitation at issue, and relied entirely on Kraus.” (Req. Reh’g. 3.) Significantly, however, the Examiner stated Liebenow “does not *explicitly* disclose” a physical representation of a control element on its touch surface, and went

on to rely on **both** Liebenow and Kraus as teaching or suggesting the claim element at issue. (Final Act. 3.) Therefore, Appellant's insistence on focusing on the disclosure of Kraus alone is precisely the type of unpersuasive argument counseled against in such authorities as *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (the test for obviousness is whether the combination of references, taken as a whole, would have suggested the patentee's invention to a person having ordinary skill in the art).

Appellant further asserts "For the first time in the record, the Board proposes to reject the claim limitation at issue based on a combination of Liebenow and Kraus," and further characterizes that combination as a "new rejection." (Req. Reh'g. 3–4.) However, as stated above, the Examiner's rejection is based on that combination. In addition, Appellant argues:

[T]he contribution of Liebenow applied by the Decision ("a touch sensitive panel on the back surface of a digital information appliance") does not add anything meaningful with respect to the claim limitation at issue. Kraus already discloses, and the Examiner relied on, Kraus' touch sensor 304 for the touch surface. (Final Office Action at 3.) The Board essentially substitutes Liebenow's touch sensitive panel 240 for Kraus' touch sensor 304. However, the claimed characteristic of the touch surface (i.e., including a physical representation of a control element), not the source of the touch surface, was the issue underlying Appellant's arguments.

(Req. Reh'g. 4.) To the contrary, the disclosure in both references of a touch sensitive surface, in the context of hand-held electronic device displays, together with the disclosure in Kraus of the keyboard overlay, reasonably supports the Examiner's finding that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use Kraus's

keyboard overlay with Liebenow's input device in order to activate a desire[d] function effectively." (Final Act. 3; Ans. 3–4.)

Appellant repeats the argument, "Kraus' overlay is separate from, not part of the touch sensor." (Req. Reh'g. 4; *see* App. Br. 6–7.) The Examiner properly rejected this argument because, under the broadest reasonable interpretation of "touch surface including at least one physical representation of a control element," the Kraus touch surface does include the keyboard overlay. (Ans. 3–4.) As the Examiner finds:

When the user presses a key area 300, the key area 300 collapses or deforms until the display actuator 306 comes into contact with the touch sensor 304 of the display screen. In the embodiment of FIG. 3c, the display actuator 306 concentrates the pressure of the user's finger into a small, well defined area on the touch sensor 304.

(Ans. 3.) We further note Kraus discloses the overlay is "securely connected" so as to properly engage with the touch surface and to be electrically connected to the device. (Kraus Fig. 4, ¶¶ 40–41.)

Furthermore, we do not agree with Appellant's assertion that the Examiner improperly "dissected" the claim element at issue. (Req. Reh'g. 5.) Appellant partially quotes from the Final Action: "the keyboard overlay represents the input keys as a physical representation of those keys." (*Id.*) However, the complete quotation is: "*The argued claimed limitation says 'the touch surface including at least one physical representation' and the keyboard overlay represents the input keys as a physical representation of those keys.*" (Final Act. 13 (Emphasis added)). Considering the Examiner's findings as a whole, we are not persuaded the Examiner erred in construing the pertinent claim language. Nor are we persuaded that any of the "intrinsic or extrinsic evidence," that Appellant

refers to, demonstrate Examiner error, or constitute points misapprehended or overlooked by the Board. (Req. Reh'g. 6.)

In summary, having fully considered the arguments in the Request for Rehearing, on this record, we are not persuaded that we have misapprehended or overlooked any points raised by Appellant. We find none of Appellant's arguments are persuasive that our Decision was in error. We have reconsidered our Decision, but decline to grant the relief requested.

DECISION

In view of the foregoing discussion, we have granted Appellant's Request to the extent that we have reconsidered the original Decision but have denied it with respect to making any changes to the Decision.

REHEARING DENIED